

REMARKS

The Final Office Action of July 21, 2004, presents the examination of claims 1-6, 8-25, 27-40, 42-86, 89 and 90; these claims remain pending. Claims 1-6, 8-25, 27-40, 42-76, 89 and 90 are allowed. Claims 77 and 83 are amended herein.

Support for amendments

Claims 77 and 83 are currently amended. The amendments made to these claims are supported by the specification at paragraphs 57 and 58 and by Figure 2.

Rejection over Carninci

Claims 77-86 remain rejected under 35 U.S.C. § 102(b) as anticipated by Carninci et al. (Genomics 1996). This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

As a threshold matter, Applicant notes that claim 86 depends from allowed claim 1. Thus, claim 86 should also be deemed allowable over the prior art of record.

Furthermore, in his reasons for allowance, the Examiner states that certain claims are allowable at least in part because, "these claims now are drawn to normalization/subtraction methods in which there is a step that removes non-specifically hybridized polynucleotide drivers." Claim 84 at least should be found

allowable as well, because that claim includes the limitation that a driver nucleic acid is being degraded. Thus, allowance of claim 84 is consistent with the Examiner's stated reasons for allowance and such is respectfully urged by Applicant.

Claims 77-83 and 85, by the term "non-specifically bound RNA/DNA hybrids having single-stranded RNA sites", or a "hybrid comprising RNA non-specifically bound to cDNA and having single-stranded RNA sites", recite that the single-stranded sites fall within a portion of RNA hybridized to DNA, not outside that portion. This location distinguishes "non-specifically hybridized" nucleic acids from specifically hybridized nucleic acids that do not match each other as to length. This distinction removes from the claims instances of the latter, *i.e.* fully matched sequences having overhanging ends, which are instances the Examiner refers to as "not specifically bound to any other nucleic acid."

To further clarify that Applicant's intention is that it is single-stranded sites falling within a portion of RNA that is hybridized to DNA that are treated by the enzyme, claims 77 and 83 are amended to expressly recite that such is the case. Applicant believes that the present amendment to claims 77 and 83 is well-supported by the specification as explained above.

Claims 77-83 and 85 are thus distinguished from what is disclosed by Carninci (Genomics 1996) and accordingly the instant rejection should be withdrawn.

Applicant submits that the present application well-describes and claims patentable subject matter. The favorable actions of withdrawal of the standing rejections and allowance of the claims are respectfully requested.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. 36,623) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions in an accompanying Notice of Appeal for a three (3) month extension of time for filing a response in connection with the present application. The fee of \$1,020.00 required for the petition is being filed concurrently with the Notice of Appeal.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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